

## **REMARKS**

In the Office Action dated May 25, 2006, the Examiner indicated that claims 1-9 and 12-14 were rejected. Claims 1-9 and 12-14 remain pending in the application. New claims 15-22 are added. No new matter is introduced as a result of these amendments, support for which is found within the specification as filed.

### **Rejections – 35 U.S.C. § 103**

#### **Claims 1-4, 9, 12, and 13**

Claims 1-4, 9, 12 and 13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Japanese Patent Application Publication No. 2002-232769 A (“*Gotanda*”) in view of Japanese Patent Application Publication No. 11-053060 (“*Tosaka*”). Applicants respectfully submit that *Gotanda* and *Tosaka*, alone or in combination, fail to teach or disclose various claimed limitations of claims 1-9 and 12-13.

Applicants respectfully submit that the present application describes, and claim 1 requires, among other things, a portable camera device having USB plug integrally adapted to the housing of the device (i.e., there is no captive USB cable), and this integrated USB plug facilitates direct coupling of the portable camera device to a USB socket of a host platform via the USB plug (i.e., there is no cable between the integrated USB plug of the portable camera device and the host platform). *See, e.g.*, Figures 2 and 2A; page 14, lines 17-24. *Gotanda* fails to teach a portable camera device that has a USB plug integrally adapted to the housing of the device to facilitate direct coupling of the device via the USB plug to a USB socket of a host platform, as disclosed and claimed in the present application.

Specifically, element 31 as shown in *Gotanda* is a USB socket (*see* Figure 2), not a USB plug as disclosed and claimed in the present application. Furthermore, the Examiner did not identify any disclosure in *Gotanda* that teaches direct coupling of the camera to a host

platform by way of a USB plug that is integrally adapted to the housing of the camera. In contrast, claim 1 of the present application requires a USB plug integrally adapted to the housing of the portable camera device, and that the portable camera device be capable of direct coupling to a USB socket of the host platform via the USB plug. Therefore, Applicants respectfully submit that *Gotanda* does not teach or disclose this claim limitation of claim 1.

Since *Gotanda* does not teach or disclose a USB plug that is integrally adapted to the housing of a portable camera device, *Gotanda* also necessarily fails to teach or disclose a non-volatile memory that is in communication with the USB plug of the portable camera device, as required by claim 1. Moreover, claim 1 includes the limitation that the digital camera is integrally formed with the non-volatile memory. In contrast, and as cited by the Examiner, *Gotanda* teaches using a *memory card* 15. A skilled artisan would readily understand that a memory card refers to a removable memory that can be conveniently inserted into or taken out of the camera by a user. Any compatible memory card can be used with the camera and can be easily swapped in and out as the user wishes. The memory card taught in *Gotanda* cannot be integrally formed with the portable digital camera disclosed therein. Therefore, *Gotanda* not only fails to disclose Applicants' claimed invention that includes an integrally formed non-volatile memory, but also teaches away from it by teaching the use of a removable memory card.

The Examiner agrees that *Gotanda* does not teach or disclose a camera having a USB plug to facilitate direct coupling of the device to the host platform. See p. 3 of the 5-25-2006 Office Action. However, the Examiner cites *Tosaka* for the contention that it remedies *Gotanda*'s deficiencies. The Examiner posits that it is obvious to modify *Gotanda* to arrive at the Applicants' claimed invention and that *Tosaka* provides the motivation to do so. Applicants respectfully disagree.

*Tosaka* does not teach or disclose direct coupling of a portable camera device to a host platform by way of a USB plug that is integrally adapted to the housing of the portable camera device. In Figure 1, *Tosaka* shows a camera device mounted on top of a notebook computer. However, disclosure of the mere fact that the housing of the camera device is set on top of the notebook computer does not by itself teach direct coupling of a portable camera device to a host platform via a USB plug that is integrally adapted to the housing of the device. These shortcomings are not remedied anywhere in *Tosaka*'s disclosures, including its specifications and other drawings. For example, Figure 5, which gives a detailed view of the individual components of the claimed camera device, lacks any teaching of an integrally adapted USB plug, as recited in the present application.

In addition, the relevant disclosures in *Tosaka* are nonenabling. A disclosure is enabling if it contains "full, clear, concise, and exact terms as to enable any person skilled in the art...to make and use the [disclosed invention]." 35 U.S.C. § 112. A reference does not render a claimed invention obvious unless the reference enables the making and usage of the claimed invention. See *Beckman Instruments, Inc. v. LKB Produkter AB*, 892 F.2d 1547, 1551 (Fed. Cir. 1989); *In re Payne*, 606 F.2d 303, 314 (C.C.P.A. 1979). *Tosaka* does not teach the type of USB interface (e.g., plug versus socket) to be used, the location of the interface on the camera device, or the form factor or sizing of the camera device. Thus, Applicants submit that *Tosaka* fails to enable any person skilled in the art to make or use the direct coupling via an integral USB plug taught in the Applicants' claimed invention.

Furthermore, Applicants submit that there is no motivation for a skilled artisan to combine the teachings in *Gotanda* and *Tosaka*. The law is clear that before prior art references can be combined, the Examiner must show some suggestion or motivation found in the art to make the combination. *In re Dance*, 160 F.3d 1339, 1343 (Fed. Cir. 1998). "It is insufficient to establish obviousness that the separate elements of the invention existed in the

prior art, absent some teaching or suggestion, in the prior art, to combine the elements.”

*Arkie Lures, Inc. v. Gene Larew Tackle, Inc.*, 119 F.3d 953, 957 (Fed. Cir. 1997). Nor is the fact that references *can* be combined sufficient to meet this criterion. *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998). The fact that the combination would be well within the ordinary skill in the art, by itself, is insufficient to meet this criterion. *Al-Site Corp. v. VSI Intern., Inc.*, 174 F.3d 1308, 1324 (Fed. Cir. 1999). The Examiner needs to show the additional step of how this knowledge of the skilled artisan leads to the suggestion or motivation.

It would not have been obvious to a skilled artisan at the time of the invention to combine *Gotanda* and *Tosaka* to arrive at the claimed invention in the present application. *Gotanda* teaches a stand-alone digital still camera while *Tosaka* teaches a camera that is specifically designed to be used only in conjunction with a notebook computer that has “a mechanism capable [of] adjusting the use angle of the camera.” [Abstract] *Tosaka* contains no statement of use for the camera device independent from the notebook computer. Therefore, there is no suggestion or motivation for the skilled artisan to combine the *Gotanda* and *Tosaka* references.

For at least the foregoing reasons, Applicants respectfully submit that *Gotanda* and *Tosaka*, either alone or in combination, fail to teach or disclose the claim limitations of independent claims 1 and 12 of the present application. If an independent claim is allowable over the cited art, then any dependent claim therefrom is also allowable over the cited art. Claims 2-4, and 9 depend on claim 1 and claim 13 depends on claim 12. As such claims 2-4, 9 and 13 are also allowable over *Gotanda* and *Tosaka*.

#### **Claims 5-7**

Claims 5-7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Gotanda* and *Tosaka* as applied to claim 1 and further in view of well-known in the art. The Examiner agrees that *Gotanda* and *Tosaka* disclose the use of only one image and/or audio

file format, JPEG, as an example, and do not expressly teach or disclose the use of a GIF, a PICT II, or a MPEG file format, which are claim limitations of claims 5-7, but states that it would have been obvious to one of ordinary skill in the art to include a GIF, a PICT II, or an MPEG file format as the one standard image and/or audio file format. Applicants respectfully traverse. The Examiner has not specifically identified any disclosure in either *Gotanda* or *Tosaka* that teaches formatting image and/or audio data in a GIF, PICT II, or MPEG file format and the Examiner has not produced any authority supporting the contention that the use of such formats would be “well-known in the art.” Moreover, because claim 1 is patentable over *Gotanda* and *Tosaka* and claims 5-7 depend on claim 1, claims 5-7 are also patentable over the cited art. For at least the foregoing reasons, Applicants respectfully submit that *Gotanda*, *Tosaka*, and facts well-known in the art, either alone or in combination, fail to teach or disclose the claim limitations of claims 5-7 of the present application.

#### **Claim 8**

Claim 8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Gotanda* and *Tosaka* as applied to claim 1 and further in view of U.S. Patent Application No. 6,753,921 B1 (“*Shimizu*”). Applicants respectfully submit that *Gotanda*, *Tosaka*, and *Shimizu*, alone or in combination, fail to teach or disclose various claim limitations of claim 8.

The Examiner agrees that *Gotanda* and *Tosaka* do not disclose a power supply circuit for receiving power from the host platform and providing said power to components of the portable camera device, as recited in claim 8. *Shimizu* is cited for the contention that it remedies these deficiencies in *Gotanda* and *Tosaka*. For the reasons discussed above, *Gotanda* and *Tosaka* fail to teach a direct connection via an integrated USB plug, which is a claim limitation of claim 1. Because claim 8 depends on claim 1 and because *Shimizu* does

not remedy that deficiency, claim 8 is patentable over *Gotanda*, *Tosaka*, and *Shimizu*, either alone or in combination. Further, there is no suggestion or motivation for the skilled artisan to combine *Gotanda*, *Tosaka*, and *Shimizu*. For at least the foregoing reasons, claim 8 should be allowable over *Gotanda*, *Tosaka*, and *Shimizu*.

#### **Claim 14**

Claim 14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. US 2003/0122839 A1 (“*Matraszek*”) in view of *Tosaka*. Applicants respectfully submit that *Matraszek* and *Tosaka*, alone or in combination, fail to teach or disclose various claim limitations of claim 14.

As discussed above, the present application describes a portable camera device that has a housing and a USB plug integrally adapted to the housing to facilitate direct coupling of the device via the USB plug to a USB socket of a host platform. The present application also teaches that the portable camera device can be used to accept identification information for authentication purposes. *See, e.g.*, page 15, line 21 to page 16, line 10. Claim 14 is directed to a method implementing such an authentication scheme using the digital camera described in the present application.

To begin, *Matraszek* does not teach a portable camera device that has a housing and a USB plug integrally adapted to the housing to facilitate direct coupling of the device via the USB plug to a USB socket of a host platform and the use of said portable camera device to accept identification information for authentication purposes. Instead, it teaches a method to retrieve digital images based on affective information; this is very different from what is claimed in the present application. Furthermore, *Matraszek* does not teach all of the steps recited in claim 14, which include capturing image/audio identification data, comparing the data against a template, and allowing access if the captured data matches the stored template. Paragraphs 67, 95, and 114 of *Matraszek* do not teach the step of comparing the captured data

against the template, as stated by the Examiner. Paragraphs 67 and 114 teach the entry of the user's personal ID and password, and Paragraph 95 teaches the use of personal affective tags to retrieve or print images. In addition, the Examiner fails to cite anything in *Matraszek* that teaches the last step of claim 14 (i.e., allowing access upon a match between the captured data and the template).

The Examiner agrees that *Matraszek* does not teach the USB connector being a USB plug to facilitate direct coupling to the host platform. *Tosaka* is cited for the proposition that it remedies the deficiencies in *Matraszek*. Applicants respectfully traverse.

As explained above, *Tosaka* does not teach or disclose direct coupling of a portable camera device to a host platform by way of a USB plug that is integrally adapted to the housing of the portable camera device. Moreover, there is no suggestion or motivation for the skilled artisan to combine the teachings of *Matraszek* and *Tosaka*. *Tosaka* teaches a camera-mounted notebook personal computer and a method for mounting the camera on the notebook computer. *Matraszek* teaches a method for determining and storing affective information associated with images and for using the affective information to retrieve digital images. The two references involve two different fields and teach two distinct endeavors. The fact that *Matraszek* and *Tosaka* refer to systems involving a computer and camera does not, without more, make the two references combinable. It would not have been obvious to a skilled artisan to combine the two references. Therefore, for at least the foregoing reasons, Applicants respectfully submit that claim 14 is allowable over *Matraszek* and *Tosaka*.

#### **Claims 15-22**

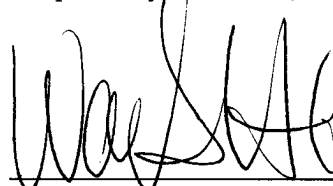
For at least the foregoing reasons stated above with respect to claims 1 through 14, Applicants respectfully submit that claims 15-22 are allowable over the cited art.

## **Conclusion**

Applicants respectfully assert that claims 1-9 and 12-22 are patentable over the cited art of record. If prosecution of this application can be expedited through a telephone interview, the Examiner is invited to call the undersigned attorney at the number below. Otherwise, early notification of allowance of claims 1-9 and 12-22 is earnestly requested.

Attached hereto is a petition for extension of time for three (3) months. In connection therewith, the Commissioner is hereby authorized to charge the fee required under 37 CFR § 1.136(a) to White & Case LLP Deposit Account No. 23-1703. Applicants are unaware of any other fees due at this time. However, if other fees are due for this extension or any other matter concerning this response, the Commissioner is authorized to charge the fees to the above-listed Deposit Account.

Respectfully submitted,



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